

REMARKS

By this amendment, new claims 79-269 have been added.

Attached herewith is a Consent of Assignee and Certificate under 37 CFR §3.73(b), as requested by the Examiner.

Regarding the Examiner's request under 37 CFR §1.178 for submission of the original patent, the present application is a continuation of reissue application Serial No. 09/016,777 that issued as RE37,342. The original patent was submitted prior to the issuance of the '342 patent. Accordingly, Applicant is not in possession of the original patent, and believes this requirement has been met.

Claims 51-78 stand rejected under 35 U.S.C. §251 as being broadened in a reissue application outside the two-year statutory period. It is believed that the Examiner is incorrect on this point, since the parent application was filed within the two-year statutory period with a request for broadened protection. *In re Doll*, 419 F.2d 925, 928, 164 USPQ 218, 220 (CCPA 1970) (If the reissue application is timely filed within two years of the original patent grant and the applicant indicates in the oath or declaration that the claims will be broadened, then applicant may subsequently broaden the claims in the pending reissue prosecution even if the additional broadening occurs beyond the two year limit.).

Attached hereto are the original reissue Declarations associated with the parent application, wherein, in paragraph 4 in each case, a statement is made that the original patent is at least partially inoperative in that less was claimed than the inventors had a right to. This case is to be distinguished with that of *In re Graff*, because the proposal for broadened claims was not made within the two-year period. *In re Graff*, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997) (Broadened claims in a continuing reissue application were properly rejected under 35 U.S.C. 251 because the proposal for broadened claims was not made (in the parent reissue application) within two years from the grant of the original patent and the public was not notified that broadened claims were being sought until after the two-year period elapsed.). See, also, *In re Fotland*, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985), cert. denied, 476 U.S. 1183 (1986) (The failure by an applicant to include an oath or declaration indicating a desire to seek broadened claims within two years of the patent grant will bar a subsequent attempt to broaden the claims after the two year limit. Under the former version of 37 CFR 1.175 (the former 37 CFR 1.175(a)(4)), applicant timely sought a "no-defect" reissue, but the Court did not permit an attempt made beyond the two-year limit to convert the reissue into a broadening reissue. In this case, applicant

did not indicate any intent to broaden within the two years.).

In this case, Applicants met the requirement of putting the public on notice that an original patent was going to be broadened on reissue within the two-year statutory period, such that subsequent continuation applications may further narrow or broaden the scope of protection.

Questions regarding this application may be directed to the undersigned attorney at the telephone/facsimile numbers provided.

Respectfully submitted,

By: 

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